

REMARKS

Applicants have added new claims 43-46. Support for this amendment can be found throughout the specification as filed. Support for new claims 43 and 45 can be found, for example, at page 5, lines 15-29; page 6, lines 23-23; Tables 4 and 5; page 35, lines 1-20; and original claims 17-18 and 23. Support for new claims 44 and 45 can be found, for example, at page 6, lines 9-24; Tables 4 and 5; page 35, lines 1-20; and original claims 25-26, 28-29 and 30-31. Applicants submit that the use of a software program as disclosed in line 6 of page 35 requires a computer, and therefore a computer is inherent in the disclosure, and recitation of "on a computer" as recited in new claims 43 and 44 does not constitute the introduction of new matter. *See M.P.E.P. § 2163.07(a).*

Applicants note that claim 17 has not been amended. Applicants respectfully submit that it would be improper for any future Office Action including a new ground of rejection of claim 17 to be made final. *See M.P.E.P. § 706.07(a).*

35 U.S.C. §§ 102(e) and 103(a) - Honkanen

Claims 17 and 40-42 are rejected under 35 U.S.C. § 102(e) as anticipated by or, alternatively under 103(a) as obvious over, Honkanen et al. (US 5,948,902). The Examiner asserts that Honkanen disclose antisense oligonucleotides targeted to human PP5. The Examiner argues that "[t]hree of the oligonucleotides synthesized contain the motif CCAC," and because the oligonucleotides were synthesized and tested, the active synthesis step is "considered to inherently include elimination of the recited negative motifs because these three sequences do not contain either the GGGG or GGA motifs." *Office Action* at 3. Applicants respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, to inherently disclose a limitation, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added).

To anticipate claim 17, Honkanen must have selected the antisense sequences of the disclosed antisense oligonucleotides by providing a set of antisense sequences, eliminating those that contained the GGGG or GGA motifs, and selecting one that contained the CCAC motif. Applicants are not aware of any express disclosure of the claimed method in the Honkanen reference. Therefore, as the Examiner apparently recognizes, the claimed method must be inherent, i.e., necessarily present, in the Honkanen disclosure.

Applicants submit that it does not follow from Honkanen's disclosure of antisense oligonucleotides which contain the CCAC motif and do not contain the GGGG or GGA motifs that Honkanen necessarily performed the steps recited in claim 17. Clearly one does not necessarily perform the steps of providing a set of sequences and then eliminating those containing GGGG or GGA motifs simply because one synthesizes an antisense oligonucleotide comprising the CCAC motif but not the GGGG or GGA motifs.

In fact, Tables 1, 4 and 5 of Honkanen provides evidence that Honkanen did not perform the steps recited in claim 17. Of the 35 antisense sequences disclosed in Tables 1, 4 and 5, only five contain the CCAC motif and neither GGGG or GGA motif. Thus, only 5 of the 35 antisense sequences could possibly be selected by the claimed method. Of the remaining 30, none contain the CCAC motif and three contain the GGA motif. Because the remaining 30 out of 35 sequences clearly were not selected by the claimed method, there is no basis to assume that the remaining 5 were selected by the claimed method.

While it may be possible that Honkanen et al. practiced the steps of the claimed methods, it is not necessary that they did so – there are numerous other possibilities for how these sequences were selected. Applicants remind the Examiner that the mere possibility or probability that Honkanen et al. performed the limitations of claim 17 is not enough for anticipation: “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added).

Nor is the claimed method obvious from the disclosure of Honkanen. The disclosure of 5 sequences that may have been selected by practicing the claimed method, along with 30 sequences that could not have resulted from the claimed method would not render the method

obvious. There is no basis for one of skill in the art to work backward from the disclosed sequences to arrive at the claimed method.

35 U.S.C. §§ 102(e) and 103(a) - MacLeod

Claims 17 and 40-42 are rejected under 35 U.S.C. § 102(e) as anticipated by or, alternatively under 103(a) as obvious over, MacLeod (US 6,066,625). The Examiner asserts that MacLeod disclosed oligonucleotides targeted to DNA methyltransferase. The Examiner argues that "SEQ ID NOs: 10 and 13, which each contain the motif CCAC," and because the oligonucleotides were synthesized and tested, "the active synthesis step is considered to inherently include elimination of the recited negative motifs because these three sequences do not contain either the GGGG or GGA motifs." *Office Action* at 4. Applicants respectfully traverse.

As stated above, to anticipate claim 17, MacLeod must expressly or inherently disclose selecting the antisense sequences of the disclosed oligonucleotides by providing a set of antisense sequences, eliminating those that contained the GGGG or GGA motifs, and selecting one that contained the CCAC motif.

For the reasons discussed above, it does not follow from MacLeod's disclosure of antisense oligonucleotides which contain the CCAC motif and do not contain the GGGG or GGA motifs that MacLeod necessarily performed the steps recited in claim 17.

In fact, Table 2 of MacLeod provides evidence that MacLeod did not perform the steps recited in claim 17. Of the 6 unique antisense sequences disclosed in Table 2, only 2 (SEQ ID NOs: 10/17 and 13/20) contain the CCAC motif and neither GGGG or GGA motif. Thus, only 2 of the 6 antisense sequences could possibly be selected by the claimed method. Of the remaining 6, none contain the CCAC motif and one contains the GGA motif. Because the remaining 4 out of 6 sequences clearly were not selected by the claimed method, there is no basis to assume that the other 2 were selected by the claimed method.

While it may be possible that MacLeod et al. practiced the steps of the claimed methods, it is not necessary that they did so. The mere possibility or probability that MacLeod et al. performed the limitations of claim 17 is not enough for anticipation: "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result

Application No.: 10/686,317
Filing Date: October 15, 2003

from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added).

Nor is the claimed method obvious from the disclosure of MacLeod. The disclosure of 2 sequences that may have been selected by practicing the claimed method, along with 4 sequences that could not have resulted from the claimed method would not render the method obvious. There is no basis for one of skill in the art to work backward from the disclosed sequences to arrive at the claimed method.

No Disclaimers or Disavowals

Although the present or prior communications may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Patents and Applications

Applicants wish to draw the Examiner’s attention to the following patents or applications. Applicants encourage the Examiner to review and monitor the prosecution of the following patents and/or applications throughout the pendency of this application.

Serial Number	Title	Filed
09/568,165	METHODS OF OBTAINING ACTIVE ANTISENSE COMPOUNDS	5/9/2000

Application No.: 10/686,317
Filing Date: October 15, 2003

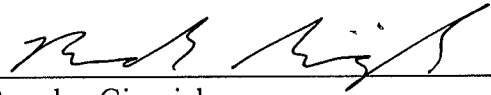
Conclusion

Applicants submit that the present application is in condition for allowance and respectfully requests an action to that effect. If any issues remain, the Examiner is invited to contact Applicants' counsel at the number provided below in order to resolve such issues promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: February 13, 2009

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